

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BJORKE DE JAEGER GOTFREDSEN

Appeal No. 2006-1477
Application No. 09/674,714¹

ON BRIEF

MAILED

JUN 13 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before RUGGIERO, BARRY, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-32, which are all of the claims pending in this application.

We affirm.

BACKGROUND

Appellant's invention relates to a card reader device which is incorporated into a mouse pad for providing the functionality of the card reader in a convenient location for the user.

¹ This application is the national stage application filed December 19, 2000 under 35 U.S.C. § 371 of PCT Application No. PCT/DK98/00531, filed December 7, 1998, which claims filing priority based on Danish Application No. 9800180 filed May 15, 1998.

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According to Appellant, the card reader is embedded in the intermediate foam rubber layer of a mouse pad and is connected to the computer by a communication cable (specification, page 5). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A unit which comprises a card read/write device, characterized in that the unit is formed by a mouse pad which is adapted to be coupled to a computer so that the coupling creates a link between the computer and the card read/write device, wherein said mouse pad comprises a relatively small pad with a substantially planar running surface.

The Examiner relies on the following prior art references:

House	4,799,054	Jan. 17, 1989
Patret ²	5,661,633	Aug. 26, 1997
Panasik et al. (Panasik)	5,987,547	Nov. 16, 1999 (filed Mar. 31, 1997)

Claims 1-13, 15, 18, 20, 23, 24 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patret.

Claims 14, 16, 17, 19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patret and Panasik.

² The Examiner relies on the U.S. Patent of the PCT Application WO 95/24008 which was initially cited by the Examiner as prior art.

Claims 25-30 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patret and House.³

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 CFR §41.37(c)(1)(vii)).

OPINION

With respect to the rejection of claims 1-13, 15, 18, 20, 23, 24 and 31, Appellant argues that Patret's "desk pad" cannot be construed as a "mouse pad" since the Examiner's broad definition of "mouse pad" as "any flat surface" is unreasonable (brief, pages 7-8). Appellant provides different dictionary definitions for "mouse pad" to limit it to a small surface and further asserts that the work surface of Patret, unlike a mouse pad, is big enough to write on (brief, page 9). Additionally, Appellant points out that although a mouse pad has a flat surface, not every flat surface may be interpreted as a mouse pad (brief, page 10).

³ The rejection of claims 1-32 under the second paragraph of 35 U.S.C. § 112 as being indefinite has been withdrawn in the answer.

The Examiner responds by stating that although Appellant's definitions specify the "rough" dimensions of a mouse pad, recitation of a "mouse pad" does not limit it to any particular size (answer, page 6). Asserting that the keyboard is placed centrally within the desk pad of Patret, the Examiner argues that the desk pad may also be a mouse pad since a mouse is placed in the same general area near the keyboard on the desk pad (id.).

Appellant responds that the desk pad of Patret may not be considered as an extra large mouse pad since its use as a mouse pad is not suggested (reply brief, page 2). Additionally, Appellant asserts that reciting the mouse pad as "a relatively small pad" excludes super-sized pads like Patret's desk pad (id.).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir.

1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). However, the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Patret describes a desk pad having a generally plane and smooth top surface wherein a keyboard and a flat screen are disposed in a central location leaving two blank zones on either side of the central zone (abstract). The pad also includes card

read/write devices 110 and 112 along the side portion of the pad frame (Figure 4; col. 5, lines 39-44). Patret further discloses that the pad includes various spaces defined by frame members 103 for housing elements such as the keyboard and the screen as well as an infrared communication device to operate a mouse. Patret specifically discloses that the elements housed in the desk pad include (col. 3, lines 33-35):

[A]n infrared transmitter/receiver device 218 for cordless communication with an auxiliary peripheral device such as a mouse (not shown) or some other device; and

Therefore, the pad is designed both with the available space and the necessary infrared transmitter/receiver for enabling a user to operate a cordless mouse in relation with the desk pad.

We agree with the Examiner (answer, page 6) that because of the centrally positioned keyboard and the fact that the mouse is used in an area near the keyboard, the desk pad of Patret may be used as a mouse pad. In that regard, although Patret does not explicitly specify a mouse pad as a part of the desk pad, the teachings of the reference, as a whole, indicate that the area of the pad that is not occupied by the other peripheral devices is available to be used as the mouse pad. We also remain unconvinced by Appellant's assertion that if the flat surface of Patret's desk pad is sufficient to qualify it as a mouse pad,

then any flat surface such as a cracker may be used as a mouse pad. Contrary to the examples listed by Appellant (brief, page 7), we note that it is the functionality and the arrangement of the peripheral devices in the desk pad of Patret that suggests using the pad as a mouse pad. In particular, the infrared transmitter/receiver device for a cordless mouse and the presence of the area near the keyboard qualify the pad as a mouse pad.

With respect to the size of the pad, we again disagree with Appellant (reply brief, page 1) that the recited term "relatively small" limits the claims to a pad not larger 24.5 cm X 20.5 cm. We also note that although Appellant's specification limits a mouse pad to such dimensions, the claimed term "relatively small" does not.⁴ Claims will be given their broadest reasonable interpretation consistent with the specification, and limitation appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). The instant specification refers to conventional mouse pads and provides the dimensions of the pad in an embodiment as 245 mm X 205 mm. However, as stated in Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir.

⁴ The non-precise term "relatively small," as acknowledged by the Examiner, may not be indefinite, but does not require us to interpret it as having the specific dimensions argued by Appellant either.

1988), what is patented is not restricted to the examples, but is defined by the words in the claims if those claims are supported by the specification in the manner required by 35 U.S.C. § 112. Here, the particular embodiments appearing in the specification will not be read into the claims since nowhere does Appellant's specification teach that the dimensions of a relatively small pad should be 245 mm X 205 mm. See also Loctite Corp. v. Ultraseal, Ltd., 781 F.2d 881, 886, 228 USPQ 90, 93 (Fed. Cir. 1985).

Therefore, we agree with the Examiner's conclusions that claim 1 merely requires that the pad be relatively small, as opposed to having the dimensions proposed by Appellant, and that modifying the desk pad of Patret to make it relatively small according to its environment would have been obvious to the skilled artisan. Accordingly, we sustain the rejection of claims 1-13, 15, 18, 20, 23, 24 and 31 under 35 U.S.C. § 103 over Patret.

Turning now to the rejection of the remaining claims, we note Appellant's designation of all the claims as falling with claim 1 (brief, page 4) and limiting the arguments to only those made with respect to claim 1. Thus, the 35 U.S.C. § 103 rejection of claims 14, 16, 17, 19, 21 and 22 over Patret and

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Panasik and of claims 25-30 and 32 over Patret and House is also sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-32 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Joseph F. Ruggiero
JOSEPH F. RUGGIERO

Administrative Patent Judge

Lance Leonard Barry
LANCE LEONARD BARRY

Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

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